

### REMARKS

Claims 1, 4-6 and 8-19 are now in the application. Claims 2, 3 and 7 have been cancelled without prejudice or disclaimer. Claim 1 have been amended to recite that “ the fat and oil contains at least about 50% by weight of a medium-chain fatty acid triglyceride”. Claim 6 has been amended to recite “fat and oil” in place of “fat or oil”. Support for the amendments to claims 1 and 6 can be found at page 11, line 18 to page 12, line 3 of the specification. Claims 1, 4 and 15 have been amended to recite “the at least one compound” for purposes of clarification for antecedent basis purposes and not to limit their scope. Claim 5 has been amended to recite “fat and oil” in place of “fat or oil” and to recite that the fat and oil “further comprises a partial glyceride”. The amendment to claim 5 finds basis at page 12, lines 3-5 of the specification. Claims 10 to 12 have been amended to recite “food or drink comprising”, “pharmaceutical preparation comprising” or “cosmetic comprising”, respectively for purposes of clarification and to address the Examiner’s comments that the term “which is used for” in these claims was merely a recitation of “intended use”. The amendments to claims 10 to 12 finds basis in the specification as a whole. Claim 14 has been amended to recite “a” in place of “an” for purposes of clarification and not to limit its scope. Newly presented claim 18 finds basis at page 12, lines 3-5 of the specification. Newly presented claim 19 finds basis in the specification as a whole. The amendments to the claims and newly presented claims do not introduce any new matter.

The objection to claim 14 has been addressed by the amendment to claim 14.

Claims 1-6, 8, 9, 11, 12, 15 and 16 were rejected under 35 USC 102 (b) as being anticipated by JP-2000-239176 (hereinafter also referred to “JP’176). JP-2000-239176 fails to anticipate claims 1, 4-6, 8, 9, 11, 12 , 15 and 16, as now amended.

According to the present invention and as recited in the claims, the fat and oil used in the fat and oil processed composition contains at least about 50% by weight of a medium-chain fatty acid triglyceride.

The medium-chain fatty acid triglyceride comprises about C<sub>6</sub> to C<sub>12</sub> fatty acids as constituent of the fatty acids (page 11, lines 23 to 24 in the specification). It is used to obtain a good shelf stability. As shown in Table 1, Compounds 1, 2, 3 and 4 (glabrene, glabridin, glabrol and 4'-O-methylglabridin, respectively) are all stable in the MCT solution.

The composition is used for prevention and/or amelioration of a life-style related disease or inhibiting and/or ameliorating increase in body weight. As shown in Example 3, the composition is effective in inhibiting the increase of body weight and in reducing visceral fat.

JP'176 discloses a composition that comprises (A) a polyhydric alcohol fatty acid ester, (B) a hydrophobic Glycyrrhizae Radix extract and (C) oil and fat.

It seems that paragraph [0015] of JP'176 is being referred to in the Office Action. which teaches that an example of the composition contains 10 to 50 % by weight of polyhydric alcohol fatty acid ester, 1 to 20 % by weight of hydrophobic Glycyrrhizae Radix extracts, and the balance of oils and fats. According to the Examiner "the balance" reads on the amount of 50% by weight or more of medium-chain fatty acid esters.

It should be noted that JP'176 discloses medium-chain fatty acid esters as unsuitable components for cosmetic use because of their unfavorable feeling and sensitization (paragraph [0006]). Namely, JP'176 teaches away from using medium-chain fatty acid esters such as medium-chain fatty acid triglyceride. JP'176 does not intend to use medium-chain fatty acid triglyceride as the oil and fat. Concerning the oil and fat (C), JP'176 teaches that dialkyl carbonate is especially preferable (paragraph [0013]).

Concerning the polyhydric alcohol fatty acid ester (A), JP'176 teaches that it is obtained from an alcohol which has two or more hydroxyl groups in the molecule and a fatty acid having 12 to 22 carbons. Diglycerol mono-fatty acid ester is especially preferable (paragraph [0012]). It is clear to those skilled in the art that JP'176 does not teach using a medium-chain fatty acid triglyceride as the component (A).

Accordingly, the fat and oil processed composition according to the present invention is not anticipated by JP'176. JP'176 fails to anticipate the present invention. In particular, anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. 102. See *Scripps Clinic and Research Foundation v. Genetech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

To the extent that inherency is being relied upon in the Office Action, it is important to keep in mind that inherency requires that the recited results or structure must necessarily be obtained not merely that it might be achieved. See *Electra Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 32 USPQ2d 1017 (Fed. Cir. 1994); *In re Oelrich*, 212 USPQ 323 (CCPA 1981); *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999); *Transclean Corp. v. Bridgewood Servs. Inc.*, 290 F.3d 1364, 1373; 62 USPQ1865 (Fed. Cir. 2002); *Cont'l Can Co. USA, Inc. v. Monsanto Co.* 948 F.2d 1264, 1269; 20 USPQ2d 1746 (Fed. Cir. 1991); and *Trintec Indus., v. Top-U.S.A.* 295 F. 3d 1292, 1295; 63 USPQ2d 1597.

Claims 1-12, 15 and 16 were rejected under 35 USC 103(a) as being obvious over JP-2000-239176 in view of JP-2003-274856 (hereinafter also referred to "JP'856"). JP'856 does not overcome the above discussed deficiencies of JP'176 with respect to rendering unpatentable the present invention.

The above discussion of JP'176 is incorporated herein by reference for purposes of linguistic economy. JP'856 discloses an edible oil and fat composition obtained by dissolving a hydrophobic extract of licorice in a diglyceride mixture. The composition is used in an oil and fat-using food.

JP'856 teaches that medium-chain fatty acid triglycerides are unsuitable as edible oil since they have problems of anus leak and low smoke point (paragraph [0005]). JP'856 teaches away from using medium-chain fatty acid triglycerides. Both JP'176 and JP'856 teach away from using medium-chain fatty acid triglycerides.

Accordingly, the fat and oil processed composition according to the present invention, that uses fat and oil containing even at least about 50% by weight of a medium-chain fatty acid triglyceride, is not rendered obvious even if JP'176 and JP'856 are combined.

The inventions according to other claims dependent from claim 1 are not rendered obvious, either.

The cited art should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. See *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 U.S.P.Q. 46 (Fed. Cir. 1986). Where, as here, the suggestion of a reference would discourage persons skilled in the art from doing what applicant taught and claimed, the reference establishes “the very antithesis of obviousness”. See *In re Buehler* 185 USPQ 781 (CCPA, 1975) and *In re Rosenberger* 156 USPQ 24 (CCPA, 1967).

Claims 13, 14 and 17 were rejected under 35 USC 103(a) as being obvious over JP-2000-239176 in view of PCT/JP01/10869 to Mae et al. (hereinafter also referred to “Mae”). The cited references do not render obvious claims 13, 14 and 17. Mae does not overcome the above discussed deficiencies of

The above discussion of JP'176 is incorporated herein by reference for purposes of linguistic economy. Mae discloses a composition containing licorice hydrophobic extract. However, Mae does not remedy the deficiencies of JP'176 and JP'856. Accordingly, the inventions according to claims 13, 14 and 17 are not rendered obvious. Claims 13, 14 and 17 are patentable for at least those reasons discussed above as to why claim 1 is patentable.

Concerning the invention according to newly added claim 19, neither JP'176 nor JP'856 teaches that the oil and fat composition containing licorice extract inhibits body weight increase.

It is not clear from Mae et al. how the licorice hydrophobic extract affects body weight of mice (Tables 2, 3, 6 and 9). Accordingly, the invention according to claim 19 is also not rendered obvious..

The mere fact that the cited art may be modified in the manner suggested in the Office Action does not make this modification obvious, unless the cited art suggest the desirability of the modification or there is well reasoned and articulated rationale to do so. This is not present in the present record. The Examiner's attention is kindly directed to *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727; 82 USPQ2d 1385 (2007), *In re Lee* 61 USPQ2d 1430 (Fed. Cir. 2002), *In re Dembiczak et al.* 50 USPQ2d. 1614 (Fed. Cir. 1999), *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), *In re Laskowski*, 10 USPQ2d. 1397 (Fed. Cir. 1989) and *In re Fritch*, 23, USPQ2d. 1780 (Fed. Cir. 1992).

Also, the cited art lacks the necessary direction or incentive to those or ordinary skill in the art to render a rejection under 35 USC 103 sustainable. The cited art fails to provide the degree of predictability of success of achieving the properties attainable by the present invention needed to sustain a rejection under 35 USC 103. See *KSR Int'l Co. v. Teleflex, Inc.*, supra, *Diversitech Corp. v. Century Steps, Inc.* 7 USPQ2d 1315 (Fed. Cir. 1988), *In re Mercier*, 187 USPQ 774 (CCPA 1975) and *In re Naylor*, 152 USPQ 106 (CCPA 1966).

Moreover, the properties of the subject matter and improvements which are inherent in the claimed subject matter and disclosed in the specification are to be considered when evaluating the question of obviousness under 35 USC 103. See *KSR Int'l Co. v. Teleflex, Inc.*, supra; *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d. 1923 (Fed. Cir. 1990), *In re Antonie*, 195, USPQ 6 (CCPA 1977), *In re Estes*, 164 USPQ 519 (CCPA 1970), and *In re Papesch*, 137 USPQ 43 (CCPA 1963).

No property or result can be ignored in determining patentability and comparing the claimed invention to the cited art. Along these lines, see *In re Papesch*, supra, *In re Burt et al.*,

148 USPQ 548 (CCPA 1966), *In re Ward*, 141 USPQ 227 (CCPA 1964), and *In re Cescon*, 177 USPQ 264 (CCPA 1973).

In view of the above, consideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

The Office is authorized to charge any necessary fees due with this paper to Deposit Account No. 22-0185, under Order No. 21581-00479-US from which the undersigned is authorized to draw.

Dated: April 28, 2010

Respectfully submitted,

By: Burton A. Amernick/  
Burton A. Amernick  
Registration No.: 24,852  
CONNOLLY BOVE LODGE & HUTZ LLP  
1875 Eye Street, NW  
Suite 1100  
Washington, DC 20006  
(202) 331-7111  
(202) 293-6229 (Fax)  
Attorney for Assignee